

## REMARKS

These remarks are in response to an Office Action of May 28, 2004. Claims 12-15, 18 and 19 are pending in the present application, claims 21-25 being withdrawn from consideration, claims 1-11, 16, 17 and 26-44 being cancelled. New claims 45-52 are presented.

First, the Applicant would like to thank Examiner Glessner for extending their counsel the courtesy of an interview on July 14, 2004 to discuss the above identified application and the reconsideration of the pending claims thereof. The present Amendment is being filed together with a recordation of the substance of the interview, in accordance with MPEP 713.04.

In the Office Action mailed May 28, 2004, the Examiner objected to claims 16 and 17 under 37 C.F.R. § 1.75(c), as being in improper dependent form for failing to further limit the subject matter of the previous claim. Furthermore, the Examiner rejected claims 1, 2, 6, 7 and 10 and 39-42 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,873,203 to Thiel in view of U.S. Patent No. 4,587,769 to Cathers; rejected claims 18 –20 under 35 U.S.C. §103(a) as being unpatentable over Thiel in view of Cathers and U.S. Patent No. 2,723,427 to Bobel; and rejected claims 26-36 under 35 U.S.C. 103(a) as being unpatentable over Bobel in view of Thiel.

As previously mentioned, the Examiner has objected to claims 16 and 17 under 37 C.F.R. § 1.75(c), as being improper dependent form for failing to further limit the subject matter of the previous claim. Specifically, the Examiner states that the limitations of claims 16 and 17 fail to further limit claim 12. In response, Applicant has cancelled claims 16 and 17 and thus the objection is rendered moot.

As a point of clarification, the nature of the remaining rejections is confusing because the Examiner formally rejected certain claims, yet in the discussion of the rejection, the Examiner included other claims as well. In response to a telephone inquiry by Applicant's

attorney, Natalie D. Kadievitch, the Examiner indicated in a phone message that the formal rejection should include the claims discussed but not formally rejected. Based on the Examiner's representation, Applicant understands the formal rejections to be as follows: claims 1-17 and 39-42 rejected under 35 U.S.C. §103(a) as being unpatentable over Thiel in view of Cathers; claims 18 –20 and 37-38 rejected under 35 U.S.C. §103(a) as being unpatentable over Thiel in view of Cathers and Bobel; and claims 26-36 and 43-44 rejected under 35 U.S.C. 103(a) as being unpatentable over Bobel in view of Thiel. Applicant will address the rejections as such. The Examiner is requested in the next communication to confirm in writing the actual basis of the rejections in the office action of May 28, 2004.

As is well settled, the Examiner bears the initial burden in establishing a prima facie case of obviousness when rejecting claims under 35 U.S.C. §103. In re Piasecki, 745 F.2d 1468, 223 USPQ 758 (Fed. Cir. 1985); In re Reuter, 651 F.2d 751, 210 USPQ 249 (CCPA 1981). If the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of non-obviousness.

To properly establish a prima facie case of obviousness, MPEP § 706.02(j) identifies three basic criteria that must be met. First, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. Second, there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or combine reference teachings. Finally, there must be a reasonable expectation of success. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1-11, 16, 17 and 26-44 have been cancelled in order to expedite the allowance of the pending claims and Applicant preserves its right to file these claims in a continuation application. Claims 1-17 and 39-42 are rejected under 35 U.S.C. §103(a) as being

unpatentable over Thiel in view of Cathers. Claims 1-11, 16, 17 and 39-42 have been cancelled. With respect to claims 12-15, the Examiner has not met his burden to show a prima facie case of obviousness because all of the elements of the claimed invention have not been demonstrated within the prior art, and no motivation to combine has been shown.

Independent claim 12 calls for a multiple-pane insulating glass unit having two spaced-apart panes and a spacer joining confronting, inner peripheral surfaces of the panes. The spacer and the confronting surfaces of the panes together define a between-pane space. At least one of the panes has an outer surface bearing a functional coating, the outer surface having a peripheral region that is substantially free of the functional coating. In addition, the pane has a coated inner surface bearing a low-emissivity coating, said coated inner surface having a peripheral region that is substantially free of the low-emissivity coating.

Thiel discloses multiple sheets maintained in a spaced relationship where the surface of each sheet facing an interior air space region between adjacent sheets is coated and has a peripheral region free of the coating. As the Examiner admits, Thiel does not disclose that both major surfaces have a peripheral region that is substantially free of the functional coating. The exterior surfaces of the sheets, i.e., the surface facing exterior, may be coated but the entire surface is coated. The exterior surfaces do not have a peripheral region that is free of the coating.

The Examiner relies on Cathers to provide the teaching missing from Thiel. It is Applicant's position that the Examiner has not established a prima facie case of obviousness because the combination of Thiel and Cathers does not teach or suggest all of the claim limitations.

Cathers deals with the conventional manner of removing a chemically-sensitive silver-based coating (for an inner surface of a multiple-pane unit) from the interior periphery of a

single pane surface in the context of fabricating glass sheets into multiple-pane units. Cathers discloses two top grinding wheels in position, one on each side of the glass so that parallel edges of film are deleted simultaneously. The substrate is conveyed in any convenient manner, e.g., by some means such as conveyor belts or rollers. There is no disclosure of removing film from an exterior surface of the pane of glass.

Further, the Examiner has not shown a motivation to combine the elements found in the prior art and apply them to an exterior surface of a pane of glass or IG unit. The applied art fails to identify problems associated with mounting a pane or IG unit having an exterior coating in the frame of a building without edge deleting the exterior coating. Cathers reflects the conventional motivation to remove the periphery of an interior silver-based coating, based upon the well-known chemical sensitivity of silver-based coatings and their tendency to degrade and potentially ruin the hermetic seal that is desired between the spacer and panes of an IG unit. Thus, although the applied art, at best, provides a motivation to edge delete an interior coating, it fails to provide a reason or motivation for edge deleting an exterior coating. In particular, this art fails to appreciate problems associated with not edge deleting an exterior coating as disclosed in Applicant's specification (e.g., from the second full paragraph of page 3 through the first paragraph of page 5), and likewise fails to appreciate the benefits providing an edge-deleted exterior coating. Therefore, a prima facie case of obviousness has not been made.

Not only does the cited art fail to provide the required motivation to combine, but it appears to teach away from the claimed invention. For example, skilled artisans would consider it undesirable to use the top-side grinding wheel of Cathers to remove a silver-based coating from the interior periphery of a pane surface to be used in a multiple-pane window unit and to then turn the pane over and use the grinding wheel to remove the periphery of a coating

on its opposite surface. The mechanism used to convey the pane to the grinder which was disclosed by Cathers would be expected to damage the sensitive silver-based coating on the side not being edge deleted which would be in direct supportive contact with rollers, casters, conveyors, or the like. As a result, skilled artisans would tend to be dissuaded from removing coating from both sides of a pane with the device disclosed in Cathers. Thus, conventional wisdom and conventional equipment, as reflected by Cathers, teaches against removing peripheral coating area from both sides of a pane.

With regard to the rejection of claims 18 -20 and 37-38 under 35 U.S.C. §103(a) as being unpatentable over Thiel in view of Cathers and Bobel, a prima facie case of obviousness has not been made. Claims 18 - 20 are dependent from independent claim 12. As discussed above, a prima facie case of obviousness has not been made for claim 12. Therefore, independent claim 12 is considered allowable, and dependent claims 18 - 20 are also considered allowable because they further limit the claimed invention. Claims 37 and 38 have been cancelled, thus the rejection is moot with respect to those claims

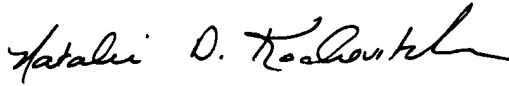
With regard to the rejection of claims 26-36 and 43-44 under 35 U.S.C. 103(a) as being unpatentable over Bobel in view of Thiel, these claims have been cancelled and thus the rejection is moot.

New claims 45-52 are fully supported by the specification of the subject application and do not present new matter.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested. The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution. The Commissioner is authorized and requested to

charge to Deposit Account No. 061910 any underpayments, overpayments, or additionally required fees.

Respectfully submitted,



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